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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/052,688	03/31/98	CLEVENGER L	98P7476US

EXAMINER	
GUAY, J	
ART UNIT	PAPER NUMBER
2814	7

MM11/0521

SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
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DATE MAILED: 05/21/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined. ☒ Responsive to communication filed on 2/16/99. ☐ This action is made final.

A shortened statutory period for response to this action is set to expire ------ month(s), 30 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☐ Notice re Patent Drawing, PTO-948.
3. ☐ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of informal Patent Application, Form PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____

Part II SUMMARY OF ACTION

1. ☒ Claim(s) 1-27 are pending in the application.
   Of the above, claim(s) _____ is withdrawn from consideration.
2. ☐ Claim(s) _____ has been canceled.
3. ☐ Claim(s) _____ is allowed.
4. ☐ Claim(s) _____ is rejected.
5. ☐ Claim(s) _____ is objected to.
6. ☒ Claim(s) 1-27 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawing(s) under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawing(s) are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction(s), filed on _____, has been ☐ approved. ☐ disapproved (see explanation).
12. ☐ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

The following is a requirement for applicants to elect claims directed to both a single **disclosed** species and to either a combination or subcombination.

This application contains claims directed to the following patentably distinct species of the claimed invention:
(1) liner material selected from titanium or tantalum metals or nitrides (as defined in Claim 4); and
(2) liner material selected from carbon, graphite, noble metals, near noble metals, and rare earth metals (as defined in Claim 6).

Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, Claims 1-3, 13, 16-19, and 26-27 are generic.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R.

§ 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-15, drawn to a conductor structure, classified in Class 257, subclass 751.

Group II. Claims 16-27, drawn to a DRAM, classified in Class 257, subclass 296.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by

itself or in other combinations. (M.P.E.P. § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed, for example, the combination does not require random grain orientation, the liner on "three surfaces of the conductor," or damascene structure. The subcombination has separate utility such as a conductor for connecting any type of non-memory switches.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication should be directed to John Guay at telephone number (703) 305-3507.

JOHN GUAY
PRIMARY EXAMINER